

Remarks

This Application has been carefully reviewed in light of the Final Office Action mailed January 26, 2007. Although Applicant believes all claims are allowable over the Examiner's rejections without amendment, Applicant has amended independent Claims 1, 13, and 15 to advance prosecution of this Application (including amending independent Claim 13 such that it no longer recites the term "means"). Applicant has amended dependent Claim 4 to correct a typographical error. Applicant has also amended dependent Claims 9-10, 17-19, and 22. Applicant respectfully requests reconsideration and allowance of all pending claims.

I. The Claims are Allowable over the Cited Combinations of References

A. Independent Claims 1, 13, and 15 and Their Dependent Claims are Allowable over the Proposed *Ward-Lewis-Cote* Combination

The Examiner rejects Claims 1, 4, 9, 13, 15, 17, and 20- 22 under 35 U.S.C. § 103(a) as being unpatentable over a proposed combination of U.S. Patent 5,367,670 to Ward et al. ("*Ward*"), U.S. Patent 6,603,396 to Lewis, et al. ("*Lewis*"), and U.S. Patent 6,021,262 to Cote et al. ("*Cote*"). Applicant respectfully traverses these rejections and discusses amended independent Claim 1 as an example.

1. The Proposed *Ward-Lewis-Cote* Combination Fails to Disclose, Teach, or Suggest Each and Every Limitation Recited in Claim 1

"To establish *prima facie* obviousness of a claimed invention, *all the claim limitations* must be taught or suggested by the prior art." M.P.E.P. § 2143.03 (emphasis added); *see also In re Royka*, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974). "*All words* in a claim must be considered in judging the patentability of that claim against the prior art." M.P.E.P. 2143.03 (emphasis added); *see also In re Wilson*, 424 F.2d 1382, 1385, 165 U.S.P.Q. 494, 496 (C.C.P.A. 1970).

At a minimum, the proposed *Ward-Lewis-Cote* combination fails to disclose, teach, or suggest at least the following limitations recited in Claim 1, as amended:

- receiving an audio command;

- processing the audio command to derive command data;
- constructing a command based on the command data; and
- storing the command in the object repository.

It does not appear that the cited portions of any of *Ward*, *Lewis*, or *Cote*, whether considered alone or in combination, disclose, teach, or suggest receiving any audio command. Thus, at least because the proposed *Ward-Lewis-Cote* combination fail to disclose, teach, or suggest “receiving an audio command,” as recited in Claim 1 as amended, the proposed *Ward-Lewis-Cote* combination necessarily fails to disclose, teach, or suggest “processing the audio command to derive command data,” “constructing a command based on the command data,” and storing the command in the object repository,” as recited in Claim 1 as amended.

For at least these reasons, the proposed *Ward-Lewis-Cote* combination fails to disclose, teach, or suggest each and every limitation recited in independent Claim 1, as amended. For at least certain analogous reasons, the proposed *Ward-Lewis-Cote* combination fails to disclose, teach, or suggest each and every limitation recited in independent Claims 13 and 15, as amended. Independent Claims 1, 13, and 15 and their dependent claims are allowable for at least this reason.

2. The Proposed *Ward-Lewis-Cote* Combination is Improper

Applicant respectfully submits that the Examiner has not provided the requisite teaching, suggestion, or motivation, either in the cited references or in the knowledge generally available to one of ordinary skill in the art at the time of Applicant's invention to modify or combine *Ward*, *Lewis*, and *Cote* in the manner the Examiner proposes. Applicant's claims are allowable for at least this additional reason.

i. The Legal Standard

The question raised under 35 U.S.C. § 103 is whether the references taken as a whole would suggest the claimed invention taken as a whole to one of ordinary skill in the art at the time of the invention. Accordingly, even if all elements of a claim are disclosed in various references, which is certainly not the case here as discussed above, the claimed invention

taken as a whole cannot be said to be obvious without some reason given in the references why one of ordinary skill at the time of the invention would have been prompted to modify the teachings of a reference or combine the teachings of multiple references to arrive at the claimed invention. It is clear based at least on the many distinctions discussed above that the proposed *Ward-Lewis-Cote* combination does not, taken as a whole, suggest the claimed invention, taken as a whole. Applicant respectfully submits that the Examiner has merely pieced together disjointed portions of references, with the benefit of hindsight using Applicant's claims as a blueprint, in an attempt to reconstruct Applicant's claims.

The governing Federal Circuit case law makes this strict legal standard clear.¹ According to the Federal Circuit, "a showing of a suggestion, teaching, or motivation to combine or modify prior art references is an essential component of an obviousness holding." *In re Sang-Su Lee*, 277 F.3d 1338, 1343, 61 U.S.P.Q.2d 1430, 1433 (Fed. Cir. 2002) (quoting *Brown & Williamson Tobacco Corp. v. Philip Morris Inc.*, 229 F.3d 1120, 1124-25, 56 U.S.P.Q.2d 1456, 1459 (Fed. Cir. 2000)). "Evidence of a suggestion, teaching, or motivation . . . may flow from the prior art references themselves, the knowledge of one of ordinary skill in the art, or, in some cases, the nature of the problem to be solved." *In re Dembiczak*, 175 F.3d 994, 999, 50 U.S.P.Q.2d 1614, 1617 (Fed. Cir. 1999). However, the "range of sources available . . . does not diminish the requirement for actual evidence." *Id.* ***Although a prior art device "may be capable of being modified to run the way the apparatus is claimed, there must be a suggestion or motivation in the reference to do so."*** *In re Mills*, 916 F.2d at 682, 16 U.S.P.Q.2d at 1432 (emphasis added). See also *In re Rouffet*, 149 F.3d 1350, 1357, 47 U.S.P.Q.2d 1453, 1457-58 (Fed. Cir. 1998) (***holding a prima facie case of obviousness not made where the combination of the references taught every element of the claimed invention but did not provide a motivation to combine***); *In Re Jones*, 958 F.2d 347, 351, 21 U.S.P.Q.2d 1941, 1944 (Fed. Cir. 1992) ("Conspicuously missing from this record is any evidence, other than the PTO's speculation (if that can be called evidence) that one of ordinary skill in the herbicidal art would have been motivated to make the modification of the

¹ Note M.P.E.P. 2145 X.C. ("The Federal Circuit has produced a number of decisions overturning obviousness rejections due to a lack of suggestion in the prior art of the desirability of combining references.").

prior art salts necessary to arrive at” the claimed invention.). Even a determination that it would have been obvious to one of ordinary skill in the art at the time of the invention to try the proposed modification or combination is not sufficient to establish a *prima facie* case of obviousness. *See In re Fine*, 837 F.2d 1071, 1075, 5 U.S.P.Q.2d 1596, 1599 (Fed. Cir. 1988).

In addition, the M.P.E.P. and the Federal Circuit repeatedly warn against using an applicant's disclosure as a blueprint to reconstruct the claimed invention. For example, the M.P.E.P. states, “*The tendency to resort to 'hindsight' based upon applicant's disclosure is often difficult to avoid due to the very nature of the examination process. However, impermissible hindsight must be avoided and the legal conclusion must be reached on the basis of the facts gleaned from the prior art.*” M.P.E.P. § 2142 (emphasis added). The governing Federal Circuit cases are equally clear. “A critical step in analyzing the patentability of claims pursuant to [35 U.S.C. § 103] is casting the mind back to the time of invention, to consider the thinking of one of ordinary skill in the art, guided only by the prior art references and the then-accepted wisdom in the field. . . . Close adherence to this methodology is especially important in cases where the very ease with which the invention can be understood may prompt one ‘to fall victim to the insidious effect of a hindsight syndrome *wherein that which only the invention taught is used against its teacher.*’” *In re Kotzab*, 217 F.3d 1365, 1369, 55 U.S.P.Q.2d 1313, 1316 (Fed. Cir. 2000) (citations omitted; emphasis added). In *In re Kotzab*, the court noted that to prevent the use of hindsight based on the invention to defeat patentability of the invention, this court requires the examiner to show a motivation to combine the references that create the case of obviousness. *See id.* *See also, e.g., Grain Processing Corp. v. American Maize-Products*, 840 F.2d 902, 907, 5 U.S.P.Q.2d 1788, 1792 (Fed. Cir. 1988). Similarly, in *In re Dembiczak*, the Federal Circuit reversed a finding of obviousness by the Board, *explaining that the required evidence of such a teaching, suggestion, or motivation is essential to avoid impermissible hindsight reconstruction of an applicant's invention:*

Our case law makes clear that the best defense against the subtle but powerful attraction of hind-sight obviousness analysis is *rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references*. Combining prior art references without evidence of such a suggestion, teaching, or motivation simply takes the inventor's disclosure as a

blueprint for piecing together the prior art to defeat patentability—the essence of hindsight.

175 F.3d at 999, 50 U.S.P.Q.2d at 1617 (emphasis added) (citations omitted; emphasis added).

ii. The Analysis

With respect to the proposed combination of *Lewis* with *Ward*, the Examiner states:

It would have been obvious to one having ordinary skill in the art at the time of the invention was made to combine the teachings of *Ward* and *Lewis* because *Lewis*'s teaching would allow *Ward*'s system to filter irrelevant alarms in order to maximize performance and reliability of the system (col. 7, lines 59-65).

(Office Action, Page 3)

It appears that the Examiner has merely proposed an alleged advantage of combining *Ward* with *Lewis* (an advantage which Applicant does not admit could even be achieved by combining these references in the manner the Examiner proposes). While the Examiner has touted an advantage of *Lewis*, the Examiner has not pointed to any portion(s) of the either reference that would teach, suggest, or motivate one of ordinary skill in the art at the time of invention to incorporate the cited teachings *Lewis* into the computer system manager disclosed in *Ward*. In other words, the alleged advantage of the system disclosed in *Lewis* does not provide an explanation as to: (1) why it would have been obvious to one of ordinary skill in the art at the time of Applicant's invention (*without using Applicant's claims as a guide*) to modify the particular techniques disclosed in *Ward* with the cited disclosure in *Lewis*; and (2) how one of ordinary skill in the art at the time of Applicant's invention would have actually done so. Indeed, if it were sufficient for an Examiner to merely point to a purported advantage of one reference and conclude that it would have been obvious to combine or modify that reference with other references simply based on that advantage (which, as should be evident from the case law discussed above, it certainly is not), then virtually any two or more references would be combinable just based on the fact the one

reference states an advantage of its system. Of course, as the Federal Circuit has made clear and as discussed above, that is not the law.

There is certainly no reason to assume that one of ordinary skill in the art at the time of Applicant's invention would have been motivated to combine *Lewis* with *Ward* in the manner the Examiner proposes. Therefore, it certainly would not have been obvious to one of ordinary skill in the art at the time of invention *to even attempt* to, let alone *to actually*, combine *Lewis* with *Ward* in the manner proposed by the Examiner.² Respectfully, the Examiner's attempt to combine *Lewis* with *Ward* appears to constitute the type of impermissible hindsight reconstruction of Applicant's claims, using Applicant's claims as a blueprint, that is specifically prohibited by the M.P.E.P. and governing Federal Circuit cases.

Accordingly, since the Examiner has not demonstrated the required teaching, suggestion, or motivation to combine *Ward* and *Lewis* in the manner the Examiner proposes, Applicant respectfully submits that the Examiner's conclusions set forth in the Office Action do not meet the requirements set forth in the M.P.E.P. and the governing Federal Circuit case law for demonstrating a *prima facie* case of obviousness. Applicant respectfully submits that the rejection must therefore be withdrawn.

With respect to the proposed combination of *Cote* with *Ward* and *Lewis*, the Examiner states:

It would have been obvious to one having ordinary skill in the art at the time of the invention was made to combine the teachings of *Ward*, *Lewis*, and *Cote* because *Cote*'s teaching of multi-tiered notification path would increase the user's flexibility of *Ward*'s and *Lewis*'s systems by allowing the user to control how and when others are to be so notified (col. 2, lines 25-36).

(Office Action, Page 3)

² If "common knowledge" or "well known" art is relied upon by the Examiner to combine or modify the references, Applicant respectfully requests that the Examiner provide a reference pursuant to M.P.E.P. § 2144.03 to support such an argument. If the Examiner relies on personal knowledge to supply the required motivation or suggestion to combine or modify the references, Applicant respectfully requests that the Examiner provide an affidavit supporting such facts pursuant to M.P.E.P. § 2144.03.

Again, it appears that the Examiner has merely proposed an alleged advantage of combining *Ward* and *Lewis* with *Cote* (an advantage which Applicant does not admit could even be achieved by combining these references in the manner the Examiner proposes). While the Examiner has touted an advantage of *Cote* (i.e., increasing user flexibility), the Examiner has not pointed to any portion(s) of the either reference that would teach, suggest, or motivate one of ordinary skill in the art at the time of invention to the escalation procedure of *Cote* into the computer system manager disclosed in *Ward* and the cited techniques in *Lewis*. In other words, the alleged advantage of the system disclosed in *Cote* does not provide an explanation as to: (1) why it would have been obvious to one of ordinary skill in the art at the time of Applicant's invention (*without using Applicant's claims as a guide*) to modify the particular techniques disclosed in *Ward* and *Lewis* with the cited disclosure in *Cote*; and (2) how one of ordinary skill in the art at the time of Applicant's invention would have actually done so. Indeed, if it were sufficient for an Examiner to merely point to a purported advantage of one reference and conclude that it would have been obvious to combine or modify that reference with other references simply based on that advantage (which, as should be evident from the case law discussed above, it certainly is not), then virtually any two or more references would be combinable just based on the fact the one reference states an advantage of its system. Of course, as the Federal Circuit has made clear and as discussed above, that is not the law.

There is certainly no reason to assume that one of ordinary skill in the art at the time of Applicant's invention would have been motivated to combine *Cote* with *Ward* and *Lewis* in the manner the Examiner proposes. Therefore, it certainly would not have been obvious to one of ordinary skill in the art at the time of invention *to even attempt* to, let alone *to actually*, combine *Cote* with *Ward* and *Lewis* in the manner proposed by the Examiner.³ Applicant respectfully submits that the Examiner's attempt to combine *Cote* with *Ward* and

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Lewis appears to constitute the type of impermissible hindsight reconstruction of Applicant's claims, using Applicant's claims as a blueprint, that is specifically prohibited by the M.P.E.P. and governing Federal Circuit cases.

Accordingly, since the Examiner has not demonstrated the required teaching, suggestion, or motivation to combine *Ward* and *Lewis* with *Cote* in the manner the Examiner proposes, Applicant respectfully submits that the Examiner's conclusions set forth in the Office Action do not meet the requirements set forth in the M.P.E.P. and the governing Federal Circuit case law for demonstrating a *prima facie* case of obviousness. Applicant respectfully submits that the rejection must therefore be withdrawn.

For at least these reasons, Applicant respectfully submits that the proposed *Ward-Lewis-Cote* combination is improper. Independent Claims 1, 13, and 15 and their dependent claims are allowable for at least this additional reason.

3. Conclusions with Respect to Claims 1, 13, and 15

For at least these reasons, Applicant respectfully submits that the Examiner has not established a *prima facie* case of obviousness based on the proposed *Ward-Lewis-Cote* combination with respect to independent Claim 1. For at least certain analogous reasons, Applicant respectfully submits that the Examiner has not established a *prima facie* case of obviousness based on the proposed *Ward-Lewis-Cote* combination with respect to independent Claims 13 and 15. Thus, for at least these reasons, Applicant respectfully requests reconsideration and allowance of independent Claims 1, 13, and 15 and their dependent claims.

B. The Separately-Rejected Dependent Claims are Allowable

The Examiner rejects Claim 3 under 35 U.S.C. § 103(a) as being unpatentable over *Ward*, *Lewis*, and *Cote* in view of U.S. Patent 6,037,099 to Sabourin, et al. ("*Sabourin*"). The Examiner rejects Claim 5 under 35 U.S.C. § 103(a) as being unpatentable over *Ward*, *Lewis*, and *Cote* in view of U.S. Patent 4,881,197 to Fischer ("*Fischer*"). The Examiner rejects

Claim 7 under 35 U.S.C. § 103(a) as being unpatentable over *Ward, Lewis, Cote, and Fischer* in view of “*Official Notice*”. The Examiner rejects Claim 8 under 35 U.S.C. § 103(a) as being unpatentable over *Ward, Lewis, and Cote* in view of U.S. Patent 6,421,707 to Miller, et al. (“*Miller*”). The Examiner rejects Claim 10 under 35 U.S.C. § 103(a) as being unpatentable over *Ward, Lewis, and Cote* in view of U.S. Patent Publication No. 2001/0044840 filed by Carleton (“*Carleton*”). The Examiner rejects Claim 11 under 35 U.S.C. § 103(a) as being unpatentable over *Ward, Lewis, and Cote* in view of U.S. Patent 6,161,082 to Goldberg, et al. (“*Goldberg*”). The Examiner rejects Claims 18-19 under 35 U.S.C. § 103(a) as being unpatentable over *Ward, Lewis, and Cote* in view of U.S. Patent Publication No. 2004/0210469 filed by Jones, et al. (“*Jones*”). The Examiner rejects Claim 23-24 under 35 U.S.C. § 103(a) as being unpatentable over *Ward, Lewis, and Cote* in view of U.S. Patent 6,185,613 to Lawson, et al. (“*Lawson*”).

Claims 3, 5, 7-8, 10-11, 18-19, and 23-24 depend from independent Claim 1, which Applicant has shown above to be allowable over the proposed *Ward-Lewis-Cote* combination, and are allowable for at least this reason. In addition, Claims 3, 5, 7-8, 10-11, 18-19, and 23-24 recite further patentable distinctions over the various proposed combinations of references. To avoid burdening the record and in view of the clear allowability of independent Claim 1, Applicant does not specifically discuss these distinctions in this Response. However, Applicant reserves the right to discuss these distinctions in a future Response or on Appeal, if appropriate. Furthermore, Applicant does not admit that the various combinations of references proposed by the Examiner are possible or that the Examiner has demonstrated the requisite teaching, suggestion, or motivation in the cited references or in the knowledge generally available to one of ordinary skill in the art at the time of Applicant’s invention to combine or modify the various references in the manner proposed by the Examiner.

The Examiner takes Official Notice of particular limitations recited in Claim 7 and asserts that such elements are well-known. Applicant respectfully traverses this Official Notice and disagrees with the Office Action regarding the alleged notoriety of these

limitations. If the Examiner intends to continue to rely on the Official Notice in rejecting any claims, Applicants respectfully request the Examiner to cite a reference or provide a signed affidavit in support of Examiner's position in compliance with MPEP § 2144.03.

For at least these reasons, Applicant respectfully requests reconsideration and an allowance of dependent Claims 3, 5, 7-8, 10-11, 18-19, and 23-24.

II. No Waiver

All of Applicant's arguments and amendments are without prejudice or disclaimer. Additionally, Applicant has merely discussed example distinctions from the reference cited by the Examiner. Other distinctions may exist, and Applicant reserves the right to discuss these additional distinctions in a later Response or on Appeal, if appropriate. By not responding to additional statements made by the Examiner, Applicant does not acquiesce to the Examiner's additional statements. The example distinctions discussed by Applicant are sufficient to overcome the Examiner's rejections.

Conclusion


Applicant has made an earnest attempt to place this case in condition for allowance. For at least the foregoing reasons, Applicant respectfully requests full allowance of all pending claims.

If the Examiner feels that a telephone conference would advance prosecution of this Application in any manner, the Examiner is invited to contact Chad D. Terrell, Attorney for Applicant, at the Examiner's convenience at (214) 953-6813.

Although Applicant believes no fees are due, the Commissioner is hereby authorized to charge any necessary fees or credit any overpayments to Deposit Account No. 02-0384 of Baker Botts L.L.P.

Respectfully submitted,

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